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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,702	03/30/2001	William B. Boyle	K35A0740	7429

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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,702

Applicant(s)

BOYLE, WILLIAM B.

Examiner

HUY T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/10/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11 –14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The detailed description of the specification do not describe overlaying information to the selected program represented by the second analog signal . It is The detailed description of the specification teaches overlaying information to the digital representation of the second analog signal .

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9 and 11- 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al (6,587,638) in view of Ohara et al (6,292,618).

Regarding claim 1, Watanabe discloses a video system (Figs 1,3 and 5) for presenting content from a content provider to a user, comprising:

an input configured to select a program from a plurality of programs, wherein the input outputs the selected program at an analog output when the selected program is represented by an analog signal;

an analog output port (11,14,15) coupled to the analog output of the tuner, wherein the analog output port is configured to be connectable to a storage device (magnetic tape or VTR) to record the selected program represented by an analog signal (column 6, lines 40-45);

an analog signal processing circuit (9,10) coupled to the analog output of the tuner to receive the analog signal representing the selected program from the tuner and to generate a digital representation of the analog signal (column 6, lines 30-40)

a first interface module (14) configured to be connectable to the storage device to receive recorded programs from the storage device (column 9, lines 8-35); and

an overlay module (18) coupled to the analog signal processing circuit and to the first interface module, the overlay module configured to selectively overlay information to a program received from one of the analog signal processing circuit and the first interface module (column 20-35).

Watanabe further teaches that the received analog program can be converted to digital signal and the digital can be processed and to be recorded by the storage

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device or to be supplied to a overlay means for overlaying with information (column 7, lines 20-51) , Watanabe fails to specifically teaches that the analog signal supplied to the storage device and to digital processing means are in two separate paths. . However it is noted that arranging and using a other path for supplying the analog signal to the storage device is merely called for a duplicate part . Therefore it would have been obvious to one of ordinary skill in the art to modify the apparatus of Watanabe by using an additional digital processing circuit for receiving the analog signal and processing the analog signal to the digital signal to be recorded by the storage device for providing multiple effect . See To duplicate parts for a multiple effect---St. Paper Co. v. Bemis Co., Inc., 193 USPQ 8 (7th Cir. 1977).

Watanabe fails to specifically teach that the input is a tuner for selecting a program.

Ohara teaches a video system having a tuner (12) for receiving the analog video programs (Fig. 21) . It would have been obvious to on of ordinary skill in the art to modify Watanabe with Ohara by using a tuner as an alternative to the input of Watanabe for receiving the video programs thereby enhancing the capacity of the video system of Warrantable for selecting a desired video program as an input video signal for recording and viewing.

Method claim 11 corresponds to apparatus claim 1. Therefore, method claim 11 is rejected by the same reason as applied to apparatus claim 1.

Regarding claims 2 and 12, Watanabe further teaches an encoder (20) coupled to the overlay module and connectable to a display device for presenting the selected program to a user (column 9, lines 25-50).

Regarding claim 3, Watanabe further teaches that the system of Claim 2, wherein the analog output port and the first interface module are configured to couple to the storage device in a parallel manner so that a selected program is recorded prior to overlaying the overlay information.

Regarding claim 4, Watanabe as modified with Ohara further teaches the tuner outputs the selected program at a digital output when the selected program is represented by a digital signal (See Ohara, Fig. 21).

Regarding claims 5 and 14, Watanabe further teaches the first interface module is part of a digital signal processing circuit, wherein the digital signal processing circuit further includes a decoder (13) coupled to be selectively in communication with the first interface module and the digital output of the tuner, wherein the decoder is configured to decompress the digital signal representing the selected program received from the digital output of the tuner, and to decompress a digital signal representing a recorded program received from the storage device via the first interface module (column 8, lines 45-50, column 9, lines 25-35).

Regarding claim 6, Watanabe further teaches the storage device is included within a digital video recorder, and wherein the digital video recorder is coupled to the analog output port and to the first interface module (column 6, lines 41-45).

Regarding claim 7, Watanabe further teaches the system of Claim 6, wherein the digital video recorder includes a video digitizer and an encoder that convert the analog signal representing the selected program into a compressed, digital signal, and wherein the digital video recorder further includes a storage medium that records the compressed, digital signal representing the selected program (column 6, lines 32-45).

Regarding claims 8 and 13, Watanabe as modified with Ohara further teaches the tuner outputs the selected program at a digital output when the selected program is represented by a digital signal (See Ohara Fig. 21).

Regarding claim 9, Watanabe further teaches the system of Claim 8, wherein the digital video recorder further includes a second interface module in communication with the first interface module, and wherein the second interface module of the digital video recorder is configured to receive digital signals from the first interface module for recording on the storage medium and to retrieve recorded programs from the storage medium (column 6, lines 32-45).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al (6,587,638) in view of Ohara et al (6,292,618) as applied to claim 9 above further in view of Maruyama et al (6,741,798) .

Regarding claim 10, Watanabe (Fig. 3) as modified with Ohara fails to teach a video data stream manager coupled between the encoder, the interface module and the storage medium, and wherein the video data stream manager controls access to the storage medium.

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Maruyama teaches a video system having a recording apparatus using a video data stream manager for controlling and accessing a storage medium (Figs 10, 19 and 25). It would have been obvious to one of ordinary skill in the art to modify Watanabe with Maruyama by providing a video stream manager as taught by Maruyama with the video system of Watanabe thereby enhancing the capacity of the video system of Watanabe in accessing the storage medium to reproduce the program.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zeidler discloses an apparatus for overlaying information to a signal from an analog source or a digital source.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

HUY NGUYEN
PRIMARY EXAMINER